

REISSUE PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Nancy L. ARNOLD et al.

Group Art Unit: 3624

Application No.: 10/716,246

Examiner: L. HAMILTON

Filed: November 19, 2003

Docket No.: 106679.99

For: DISPOSABLE EYE PATCH AND METHOD OF MANUFACTURING A DISPOSABLE EYE PATCH

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR §1.56, the attention of the Patent and Trademark Office is hereby directed to the references listed on the attached PTO-1449. Unless otherwise indicated herein, one copy of each reference is attached. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

- ☒ 1. This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection, Notice of Allowance, or other action that closes prosecution (e.g., Quayle Action), but before payment of the Issue Fee. The fees associated with this filing under 37 C.F.R. §1.17(i) are being paid electronically with this filing. The Commissioner is hereby authorized to charge any additional fee (or credit any overpayment) associated with this communication to Deposit Account No. 15-0461.
- ☒ a. I hereby certify that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, was known in connection with above-identified application to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 CFR §1.97(e)(2).
- ☒ 2. The references were cited in co-pending application 09/988,335 in an Office Action dated May 18, 2007, and applied in rejections of claims including some features that are similar to some of the features recited in the claims of the present application. A copy of that Office Action is attached for the Examiner's reference. Six references are cited on the Form PTO-892 attached to the Office Action; however, three of those references have already been considered of record in the above-identified reissue

application. Thus, only the three references that have not yet been considered in the reissue application are listed on the Form PTO-1449 attached hereto.

- ☒ 3. In accordance with 37 CFR §1.98(a)(2)(ii), copies of any U.S. patents and patent application publications are not attached.

Respectfully submitted,



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WPB:JAN/scg

Date: June 1, 2007

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<p><b>DEPOSIT ACCOUNT USE AUTHORIZATION</b> Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
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Form PTO-1449  
(REV. 1/06)US Dept. of Commerce  
PATENT & TRADEMARK OFFICEATTY DOCKET NO.  
106679.99APPLICATION NO.  
10/716,246

## INFORMATION DISCLOSURE STATEMENT

(Use several sheets if necessary)

APPLICANT(S)  
Nancy L. ARNOLD et al.FILING DATE  
November 19, 2003GROUP  
3624

## U.S. PATENT DOCUMENTS

Examiner Initials	Cite No.	Document Number	Date	Name
	1	5,918,600	07/06/1999	Durette
	2	5,309,925	05/10/1994	Policastro
	3	4,790,031	12/13/1988	Duerer

## FOREIGN PATENT DOCUMENTS

Examiner Initials	Cite No.	Document Number	Date	Country	With English Abstract	With English Translation

## OTHER DOCUMENTS

Examiner Initials	Cite No.	(Including Author, Title, Date, Pertinent Pages, etc.)

EXAMINER

DATE CONSIDERED

Examiner: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Date: June 1, 2007



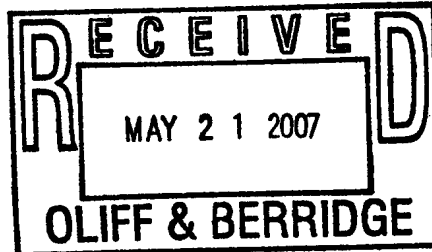
# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,335	11/19/2001	Richard L. Pellegrini	106679.01	8588

7590  
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05/18/2007



EXAMINER

BROWN, MICHAEL A

ART UNIT PAPER NUMBER

3772

MAIL DATE DELIVERY MODE

05/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## REJECTION

DUE DATE

AUG 18 2007

DOCKETED  
By COT on 5/21 2007  
and  
By Fmp on 5/21 2007  
Oliff & Berridge

## Office Action Summary

Application No.

09/988,335

Applicant(s)

PELLEGRINI ET AL.

Examiner

Michael Brown

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-40, 45, 58, 59 and 63-99 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-40, 45, 58-59 and 63-99 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-25, 27-29, 31-34, 37-38, 40, 45, 58-59, 63-65 67-71, 73-75, 77, 79-86, 88-90, 92 and 94-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duerer in view of Gonsett, along with Durette.

Duerer discloses in figures 1-2 an eye shield comprising a sheet member 22, comprising an eye-covering portion (fig. 1), sized to fit entirely within a human eye socket (oval shaped just as the present invention is), a metallic layer (aluminum that is a foil) 26, attached to the sheet (fig. 2), to protect eye from sun light, the metallic layer has a plan-view shape (fig. 2), the plan-view shape including an eyeball-covering area (fig. 1), that completely covers an eyeball, the plan-view shape being continuous over the eyeball-covering area, the metallic layer is smaller than the sheet material and does not overlap a peripheral portion of the sheet member (fig. 2), the metallic layer is a pure metal (aluminum), the metallic layer is not part of a metallized polymer layer, a method of protecting a patient's eye by adhering a disposable, light resistant eye patch over the eye entirely within a corresponding eye socket of the patient in at least one dimension of the eye socket, the sheet member is sized to fit entirely inside the eye socket in both a

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lateral and vertical dimension of the eye socket (the oval shaped provides for the sheet member to fit within the lateral and vertical dimensions of the eye socket), the peripheral portion extends along the entire periphery of the sheet member (fig. 1) and the metallic layer doesn't overlap any part of the peripheral portion (fig. 1), the method is light treatment and the plain view is continuous over its entirety (fig. 1). However, Duerer doesn't disclose the light being a laser light, the patch being without something to hold it onto the face (i.e. a strap) or the metallic material being stainless steel. Gonsett teaches in figure 6 an eye patch A, that is (egg shaped) and made of metallic material (col. 2, lines 10-12). The eye patch A is sized and shape (ovoid, egg shaped) to fit within the vertical and lateral dimension of the eye socket. Durette teaches in figures 1-5 an eye shield comprising a metallic layer 10, (stainless steel, col. 2, lines 10-13), used to prevent laser light from pass therethrough (col. 1, lines 37-41). It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the eye shield disclosed by Duerer could be fabricated as an eye patch as taught by Gonsett. The metallic layer (stainless steel) as taught by Durette could be substituted for the metallic layer disclosed by Duerer in order to used the eye patch to prevent a laser light from passing therethrough. The thickness of the sheet member and the thickness of the metal layer recited in the claims aren't critical dimensions that provide any novelty over the prior art. The sheet 22, is only located on one side of the metallic layer. Note: Most people are categorized into three distinctive groups. The first is Caucasoid, the second is Mongoloid, who tend to have an epicantic fold, imparting an almond shape to the eye. The third group of people is referred to as Negroid. These

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three groups of people tend to have different shaped eye. Thus, an eye patch may fit into the eye socket in a vertical and lateral direction on one group of the people. While on the other hand the same eye patch might fits outside of the eye socket on another group of people. Also, a large man's eye socket might allow the eye patch to fit vertically and laterally within the eye socket. On the other hand the same eye patch will cover the entire eye socket and a portion of the face of a small child.

Claims 26, 72 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims above, and further in view of Krupnick.

Krupnick teaches in figures 1-3 an eye patch comprising a sheet 24 having an adhesive 30, applied over at least the peripheral edge of the sheet. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the adhesive layer as taught by Krupnick could be incorporated into the eye patch disclosed by Duerer and taught by Gonsett and Durette in order to use the adhesive to attach the eye patch to the eye socket.

Claims 30, 76 and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims above, and further in view of Langley.

Langley teaches in figures 1-4 an eye patch comprising a sheet member 10 made of biocompatible foamed plastic material (col. 3, lines 37-42). It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the sheet member disclosed by Duerer and taught by Gonsett and Durette could be



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fabricated of a biocompatible foam plastic material as taught by Langley because it is a soft material that wouldn't chafe the skin around the eye, yet it is durable enough to protect the eye.

Claims 35-36 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims above, and further in view of Policastro.

Policastro discloses in figures 1-10 a diffuse reflective laser barrier that can be an eye shield that is made of pure aluminum, an aluminum alloy or a metal alloy (col. 4, lines 16-28). It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the pure aluminum, aluminum alloy or the metal alloy as taught by Policastro could be used as the metallic layer to block laser light from a patient's eye. Policastro provides the needed teaching that aluminum as disclosed by Duerer could be used to also block laser light.

Claims 66, 78 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims above, and further in view of Kohn.

Kohn teaches in figure 9 an eye patch comprising a tab 34. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the tab as taught by Kohn could be incorporated into the eye patch disclosed by Duerer and taught by Gonsett and Durette in order to use the tab to grasp and remove the eye patch from around the eye socket.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is 571-272-4972. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Brown/  
May 11, 2004

**Notice of References Cited**Application/Control No.  
09/988,335Applicant(s)/Patent Under  
Reexamination  
PELLEGRINI ET AL.Examiner  
Michael BrownArt Unit  
3772

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**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-2,283,752	05-1942	GONSETT FAUST R	2/15
*	B	US-4,709,695	12-1987	Kohn et al.	128/858
*	C	US-4,790,031	12-1988	Duerer, Stormy W.	2/439
*	D	US-4,969,472	11-1990	Langley et al.	128/858
*	E	US-5,309,925	05-1994	Policastro, Peter P.	128/849
*	F	US-5,918,600	07-1999	Durette, Jean-Francois	128/857
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.